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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 09/582,471 | 08/15/2000 | DIRK FREUND | 1826-017 | 8771 |
| 9629 | 7590 | 07/23/2004 | | |
| MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | EXAMINER NASSER, ROBERT L | |
| | | | ART UNIT 3736 | PAPER NUMBER |

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/582,471 | FREUND ET AL. | |
| | Examiner | Art Unit | |
| | Robert L. Nasser | 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 April 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 43-49 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 43-49 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada JP 01265939 in view of Ota et al. Terada teaches a method of measuring blood pressure using a cuff disposed so that a body of the cuff lies on the thumb side of the wrist. It does not teach placing the device against the chest before making the measurement. However, Ota et al teaches that when using a wrist blood pressure measuring device, errors occur if the device is not at the same level as the heart. In the second embodiment (figure 7), Ota includes a sound sensor that is placed on the chest to locate the heart and ensure accurate readings. Hence, it would have been obvious to modify Terada to use such a sound sensor, so as to ensure the accuracy of the readings. Claim 44 is rejected in that the sound sensor functions as a positioning system. Claim 45 is rejected in that the positioning system gives an audible indication of the proper positioning via buzzer 9. With respect to claims 46-48, Ota does indeed indicate whether the cuff is at the proper position or not. It does not use arrows. However, applicant has given no reason why arrows were selected and applicant has not stated that arrows solve a stated problem. As such, it would have been a mere matter of design choice for one skilled in the art to choose the proper indication technique.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terada in view of Peel III. The only difference between Ota and the invention of claim 49 is that the present claimed invention automatically triggers the blood pressure measurement upon satisfaction of the condition, e.g. proper positioning. Peel III is a device that makes blood pressure measurements that detects a condition and when the condition is satisfied (passage of a predetermined time period since the last measurement- see page 17, lines 21-27) automatically triggers a measurement. From this teaching, it would have been obvious to modify the above combination et al to automatically trigger the measurement, to simplify its operation

Applicant's arguments filed 4/28/2004 have been fully considered but they are not persuasive.

Applicant has asserted that since Ota shows no details of the invention, it is unclear whether a pronated wrist lies against he chest of the patient. The examiner first notes that nothing in the claims requires a pronated wrist to be placed against the chest, only that the wrist is placed against the chest. The wrist encircles the arm such that even if the acoustic sensor were on he side of the device, it would still be on the wrist. Second, the examiner notes that there is one box 12 containing the blood pressure meter shown schematically in figure 5. The box is against the chest and it is the examiner's position that the wrist, or at least a portion of it, is too.

With respect to Peel, the examiner notes that in column 17, lines 21-27, Peel teaches triggering a measurement base don a satisfaction of a condition.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
July 19, 2004



ROBERT L. NASSER
PRIMARY EXAMINER